



2821

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<h1>TRANSMITTAL FORM</h1> <p><i>(to be used for all correspondence after initial filing)</i></p>		Application Number	09/809,121
		Filing Date	March 15, 2001
		First Named Inventor	Daniel LIEBERMAN
		Group Art Unit	2821
		Examiner Name	Hoang V. NGUYEN
Total Number of Pages in This Submission	4	Attorney Docket Number	7544-PA03

ENCLOSURES (check all that apply)		
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	James W. McClain
Signature	
Date	March 6, 2002

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT
#3131
JGM
3/12/02

In Re Application of) For: METHOD FOR THE FORMATION OF
DANIEL LIEBERMAN) RF ANTENNAS BE DEMETALLIZING
Serial No.: 09/809,121) AND RF ANTENNA PRODUCTS
Filed: March 15, 2001) FORMED THEREBY
) Group Art Unit: 2821

RESPONSE UNDER 37 C.F.R. § 1.143

Hon. Commissioner for Patents
P.O. Box 2327
Arlington, VA 22202

Attention: Hoang V. Nguyen
Examiner

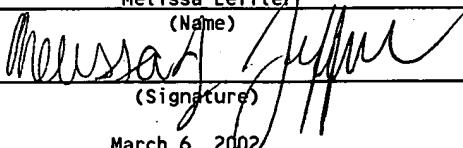
Dear Sir:

This communication is in response to the Office Action dated February 11, 2002.

In the subject Office Action the Examiner issued a restriction requirement calling on Applicant to elect between method Claims 1-25 (Group I) and apparatus Claims 26-30 (Group II) for examination. Applicant hereby provisionally elects the Group I method claims (Claims 1-25) as required by 37 C.F.R. § 1.134.

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March 6, 2002

Melissa Leffler
(Name)

(Signature)
March 6, 2002
(Date of Signature)

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Notwithstanding the provisional election, however, Applicant respectfully traverses the restriction requirement. The Examiner has contended that the two aspects of the invention are separately classified and are related as process of making and product, citing M.P.E.P. § 806.05(f), and that they therefore have acquired a separate status in the art. Applicant submits that this rationale is not applicable in the present case, and that the method and apparatus claims are to aspects of the same invention which necessarily require co-extensive searches and are therefore properly maintained in the same application.

As to the argument of separate classification, it has long been recognized that separate classification alone is not acceptable grounds for artificially partitioning a unitary invention; *Ex Parte Goldsmith*, 155 U.S.P.Q. 107 (P.T.O. Bd.App., 1966). As *Goldsmith* makes clear, the PTO's classification system is an in-house database organized along the lines of the PTO's own internal organization, and does not constitute any division of technology defined or accepted by those skilled in the art outside the PTO.

As to the process/product rationale, it will be recognized that the two are clearly closely related aspects of the same invention, and as such will require virtually identical fields of search. While antennas can be made by other processes, that is not relevant, since it will be recognized that the antennas claimed in Claims 25-30 are limited to those which are made by the process of Claims 1-25. A co-extensive search is therefore a necessity.

Further, the Examiner is relying upon classification of the method in class 29, subclass 600, and the antennas in class 343, subclass 700MS. Inspection of the PTO's Manual of Class Definitions for these classes/subclasses shows that the definition of subclass 29/600 cross-references to 343/700+ and vice versa. Thus the PTO itself recognizes that the two aspects the antenna formation and structure are inherently interrelated, and that a proper prior art search for either aspect must necessarily include a search of *both* search classifications.

Thus, since identical and co-extensive searches are required, restriction in this case

will merely result in duplication of effort and added burden for the Examiner, as well as unnecessary doubling of costs for the Applicant.

Consequently it is submitted that this case clearly falls within the overriding provisions of *M.P.E.P. § 803, second paragraph*, requiring that the Examiner examine the entire application on its merits where such would effectively minimize the search effort. Therefore Applicant believes that withdrawal of the restriction requirement and examination of *all Claims 1-30* in this application is appropriate under the USPTO's required procedures and such is respectfully urged.

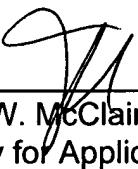
In the event that the Examiner elects to maintain the restriction requirement, Applicant reserves his right under 35 U.S.C. § 121 to file one or more divisional applications covering the subject matter of non-elected Claims 25-30.

It is not believed that any fees are due with respect to this response. However, should any such fees be due, the Patent and Trademark Office is authorized to charge all such fees to Deposit Account No. 02-4070.

Should the Examiner believe that prosecution of this application might be expedited by further discussion of the issues, he is cordially invited to telephone the undersigned attorney for Applicant, collect, at the telephone number listed below.

Respectfully submitted,

Date: March 6, 2002

By: 
James W. McClain, Reg. No. 24,536
Attorney for Applicant

BROWN, MARTIN, HALLER & McCLAIN, LLP
1660 Union Street
San Diego, California 92101-2926

Telephone: (619) 238-0999
Facsimile: (619) 238-0062
Docket No.: 7544-PA03